

REMARKS

In the Office Action¹, the Examiner rejected claims 1, 3, 5, 6, and 8-11 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication 2004/0225711 A1 to Burnett et al. ("Burnett"), in view of U.S. Patent 6,775,830 to Matsunami et al. ("Matsunami"), and further in view of U.S. Patent 5,784,552 to Bishop et al. ("Bishop").

Applicants have amended claims 1, 3, and 6, and cancel claims 5, and 8-11 without prejudice or disclaimer. Claims 1, 3, and 6 are currently pending.

I. Interview of May 14, 2009

As an initial matter, Applicants thank the Examiner for the courtesies extended during the interview with Applicants' representative on May 14, 2009. During the interview, proposed claim amendments were presented, which the Examiner indicated would overcome the prior art of record, as the Examiner agreed none of Burnett, Matsunami, or Bishop teach or suggest "waiting a prespecified amount of time and then deinstalling the application if there is no additional request for the resource received with the prespecified amount of time." However, the Examiner noted that a new non-final Office Action might be issued. In response to this, Applicant's representative proposed further claim amendments, and the Examiner agreed that the proposal, along with incorporating features from dependent claims 5 and 8 into their respective independent claims, would receive favorable consideration for an allowance of the

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

application. The interview concluded with the Examiner agreeing to review additional proposed claim amendments prior to Applicants filing a response to the non-final Office Action.

Accordingly, Applicants prepared additional proposed claim amendment based on the Examiner's remarks, and submitted these proposed claim amendments to the Examiner on May 14, 2009. On May 18, 2009, the Examiner indicated that the latest set of proposed claims would receive favorable consideration for a possible allowance, and urged Applicants to submit a response based on the proposed claims. The Examiner indicated that he will update a search, and contact Applicants if there are any outstanding issues.

Applicants have amended independent claims 1, 3, and 6 based on the proposed claim amendments. Finally, Applicants request that the Examiner contact Applicants' representative if further action is necessary for placing the application in condition for allowance

II. Regarding the rejection of claims 1, 3, 5, 6, and 8-11 under 35 U.S.C. § 103(a) as being unpatentable over Burnett in view of Matsunami and Bishop

Applicants respectfully traverse the Examiner's rejection of claims 1, 3, 5, 6, and 8-11 under 35 U.S.C. § 103(a) as being unpatentable over Burnett in view of Matsunami and Bishop. Claims 5 and 8-11 have been canceled, with their subject matter being incorporated into their respective independent base claims. Furthermore, a *prima facie* case of obviousness has not been established with respect to claims 1, 3, and 6.

“The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]ejections on obviousness cannot be sustained with mere conclusory statements.” M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007) (internal citation and inner quotation omitted). “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art.” M.P.E.P. §2143.01(III) (emphasis in original). “In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” M.P.E.P. § 2141.02(I), (emphasis in original).

“[T]he framework for objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art.” M.P.E.P. § 2141(II). “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III).

For example, amended claim 1 recites, among other things, manager services configured to:

determine whether an application having the first application class type is currently installed on the respective associated computer system;

install the first application . . . to modify the behavior of the resource of the respective associated computer system . . . upon determining that a second application having the first application class type is not yet installed on the respective associated computer system; [and]

waiting a prespecified amount of time and then deinstalling the application if there is no additional request for the resource received within the prespecified amount of time

(emphases added). As agreed during the interview, the prior art, taken alone or in combination, fail to teach or suggest at least these elements of Applicants' claimed invention.

The Office concedes, "Burnett-Matsunami . . . do not explicitly disclose wherein said logged changes made during installing of the application file includes, revert the respective associated computer system to an original state including removing modification made to the respective associated computer system based on the logged changes without restarting the computer system, upon determining that the resource is no longer needed," and relies on Bishop. Office Action at 5. Furthermore, the Office relies on a combination of Burnett and Bishop as allegedly disclosing "wherein determining that the resource is no longer needed is performed by the manager services waiting a prespecified amount of time and then deinstalling the application file if there is no additional request for the resource," as currently recited in amended independent claim 1, and previously recited in now canceled claim 9. See Office Action at 9.

Bishop discloses a "debugging mode that permits a programmer to step through a program while viewing the contents of registers and selected memory locations." Bishop, col. 1, ll. 9-11. "[T]here is provided a method of executing a computer program

in a forward direction in order to create a current state of registers and memory for the computer program. Before each instruction of the computer program is executed, however, pre-existing values of the registers and the memory that are changed by the instruction are recorded in a main log. By using the main log, reverse execution is simulated in order to display contents of registers or memory locations specified by a programmer during interactive debugging.” Bishop, col. 2, ll. 30-39. “Logging in the main log 74 starts at the beginning of execution or at some mid-point during execution of the application program, and continues until the end of execution of the application program.” Bishop, col. 9, ll. 7-10.

The Office alleges that paragraphs [0011], [0012], and [0039] of Burnett, and Figures 4, 5, and 14-16, as well as column 14, lines 9-43, and column 8, line 30 to column 9, line 28 of Bishop, cited to by the Office on page 9 of the Office Action, disclose “waiting a prespecified amount of time and then deinstalling the application file if there is no additional request for the resource received within the prespecified amount of time,” as recited in amended claim 1. Applicants respectfully disagree. The cited portions of Burnett are unrelated and do not mention deinstallation of any application file.

Furthermore, Bishop is completely unrelated to the field of grid management, and discloses only that a log file may be used in stepping through execution history of an application during debugging of an application program. The portion of Bishop cited by the Office only “displays a message to the user indicating that the end of the program has been reached, and execution returns.” Bishop, col. 14, ll. 16-18. As discussed during the interview, and agreed upon by the Examiner, there is no discussion in any of

the cited portions of Bishop of any prespecified amount of time, or of waiting this prespecified amount of time, and then deinstalling an application if there are no additional requests for a resource received within the prespecified amount of time.

Nothing in the cited portions, nor any other portions of Burnett, Matsunami, and Bishop teach or suggest “waiting a prespecified amount of time and then deinstalling the application file if there is no additional request for the resource received within the prespecified amount of time,” as recited in amended claim 1, and previously recited in dependent claim 9. The Office has failed to establish a *prima facie* case of obviousness with respect to at least this element, and the rejection must be withdrawn for at least this independent reason.

Furthermore, independent claim 1 has been amended to recite, “determin[ing] whether an application having [a] first application class type is currently installed on the respective associated computer system [and] install[ing] the first application . . . to modify the behavior of the resource of the respective associated computer system . . . upon determining that a second application having the first application class type is not yet installed on the respective associated computer system.” None of Burnett, Matsunami, or Bishop, taken alone or in any combination, teach or suggest determining an application class type, or of determining whether a second application having the application class type is installed.

As such, Burnett, Matsunami, and Bishop, taken alone or in combination, do not teach or suggest at least “determin[ing] whether an application having the first application class type is currently installed on the respective associated computer system; install[ing] the first application . . . to modify the behavior of the resource of the

respective associated computer system . . . upon determining that a second application having the first application class type is not yet installed on the respective associated computer system; [and] waiting a prespecified amount of time and then deinstalling the application if there is no additional request for the resource received within the prespecified amount of time," as recited in amended claim 1 (emphases added).

Independent claims 3 and 6, while of different scope than claim 1, recite elements similar to those of claim 1, and are thus allowable over Burnett, Matsunami, and Bishop for at least similar reasons as claim 1.

III. Conclusion

In view of the foregoing, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.


If the Examiner believes a telephone conference would be useful in resolving any outstanding issues, the Examiner is invited to call the undersigned at (202) 408-4268.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: May 19, 2009

By: 

Trenton J. Roche
Reg. No. 61,164